

REMARKS

The final Office Action dated November 17, 2003, has been carefully considered, in which new rejections were raised, based in part upon Applicant's recent submissions in an Information Disclosure Statement. By way of this amendment, claims 14-18, 38 and 43 have been cancelled without prejudice to narrow the issues in this prosecution, since it appears that this application may unfortunately be heading toward appeal. Claims 46-49 are added. Claims 1-13, 19-37, 39-42, 44-45, and 46-49 remain in the present patent application. Applicant respectfully requests reexamination and reconsideration of the claims in view of the foregoing amendments and the following remarks.

First, turning to the indefiniteness rejections, claims 7-45 have been rejected under § 112 for failing to comply with the written description requirement. Specifically, the Patent Examiner has asserted that the newly added limitation of pigments in "free of pre-measured individual units" does not appear to have support in the original disclosure. However, the Examiner acknowledges that the original disclosure has support for "pigments in powder form" (see page 8, lns. 7-8 and FIG. 1). According to the reasoning advanced in the Office Action, the original disclosure does not have support for pigments in bulk form free of pre-measured individual units because said pigments may be counted in order to fill a certain volume such as a measuring spoon.¹ See Office Action, pgs. 2-3. In response, it is respectfully submitted that MPEP § 2163.07(a) is controlling. In particular, this section recites that "by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, the patent application necessary discloses that function, theory or advantage even though it says nothing explicit concerning it." MPEP § 2163.07(a). In the present case, it is axiomatic that pigments in powder form when stored in bulk containers as shown in the drawings and used according to the invention are "free of pre-measured individual units". That is an inherent property in such pigments. Furthermore, the specification recites according to one embodiment "the retailer can pour pigments 24 directly onto the translucent blending sheet 30 using the graduated segments of the measuring sheet at 22 as a guide." Page 6, lns. 22-24. The explicit definition of "pour" (see attached dictionary definitions) makes very clear and specifically uses the word "liquid" as part of the definition. "Pour" in common use refers to liquids. Accordingly, by using the word pour and by showing containers in the drawings with reference to a blending sheet with graduated segments, it is self-evident and inherent that the pigments being may be in liquid or alternatively powder form as explicitly disclosed and that by

¹ As a preliminary matter, the Patent Examiner is incorrect that a measuring spoon may be used to count pigments, a measuring spoon is used to measure and is not for purposes of counting.

definition they are not in pre-measured units when stored in bulk form as shown in the drawings. In this regard, claims 46-49 have been added as it relates to use of at least one liquid pigment. Because MPEP § 2163.07(a) specifically allows for the later inclusion of an inherent "property", even though the specification "says nothing explicit concerning it", Applicant respectfully requests the Examiner to withdraw the first § 112 rejection.

In a similar vein, regarding claims 36-40, the Patent Examiner has objected to the use of "without counting pellets". Nowhere in Applicant's disclosure does it mention or reference the use of counting pellets. What Applicant has done in effect is put in a negative limitation (which are proper under the MPEP) to explicitly and clearly differentiate the cited Collins reference. Again, it is an inherent property that pigment or liquid form is not in the form of pellets to be counted by definition. Accordingly, under MPEP § 2163.07(a), this indefiniteness rejection cannot stand either.

Finally, the last § 112 rejection relates to Applicant's claiming of "at least one pigment in powder form". Clearly, the patent application discloses at least one pigment in powder form as acknowledged by the Patent Examiner, which may include all pigments in powder form. Apparently, the Patent Examiner believes that the Applicant must claim that all pigments are in powder form, but this is not required under MPEP § 2163.05 which allows for the omission of a claim limitation such as "all" as inferred by the Patent Examiner. Applicant is entitled to the broadest scope possible and therefore this rejection is improper under MPEP § 2163.05. It is further improper under MPEP § 2163.07(a). Specifically, under the explicit definition of "pour" which specifically references liquids as part of its definition, it is an inherent property and therefore disclosed and contained within the patent application "even though the specification says nothing explicit concerning it" pursuant to MPEP § 2163.07(a).

In view of the foregoing, Applicant respectfully requests all § 112 rejections to be withdrawn.

The clear contradiction between the § 112 and the prior art rejections can readily be seen in the reasoning of the Office Action since it is asserted there is no inherent properties or functions contained in Applicant's disclosure, but apparently in the same breathe there are all kinds of inherent properties, functions and methods being performed in the cited references (e.g. Jean Putz et al., Exhibit A), despite the fact that the additional documents submitted appear to be catalogs and literature pertaining to raw materials. The Patent Examiner must keep in mind that cited prior art references are limited to what is disclosed explicitly or inherently in those publications. Regarding the anticipation rejections, Applicant has

effectively narrowed the issues by virtue of cancellation of certain claims without prejudice, thereby narrowing the issues.

Turning to the anticipation rejections then, the anticipation rejections are respectfully traversed. First, regarding claim 7, Jean Putz et al. (Exhibit A), does not disclose "receiving a customer demand from a person for a customer blended lip coloring product at the retail establishment", or conducting certain steps based upon that customer demand as is recited. Accordingly, the anticipation rejections cannot stand. The Patent Examiner's reference to "functional limitations" is not applicable under any rules of the MPEP, particularly in a method claim which recite only functional limitations by virtue of being a method claim. Indeed, under MPEP § 2173.05(g) "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it clearly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." The Patent Examiner should note that MPEP § 2114 is not available due to the fact that this is not an apparatus and article claim, but a method claim. Accordingly, because an entire step and additional claim limitations are missing, claim 7 and all dependents therefrom cannot be considered to be anticipated by Jean Putz et al. (Exhibit A).

It should further be noted that Jean Putz et al. (Exhibit A) fails to disclose the additional specific steps recited under claims 8, 9 (Putz et al. appears to relate to recipes, and does not appear to disclose adjustment) and 10 (no blending sheet is provided or shown in Putz et al.).

In a similar vein, claim 26 is also not anticipated either because it recites "receiving a demand from an individual person for a custom blended lipstick at the retail establishment" which is also similarly not disclosed in Jean Putz et al. (Exhibit A) based upon the available information. Furthermore, measuring step is in accordance with the demand of the individual person relating the method again to the demand that is received at the retail establishment. Accordingly, claim 26 and its dependent claims cannot be considered to be anticipated over Jean Putz et al. (Exhibit A).

Turning then to the § 103 rejections, the rejection of claim 16 in paragraph 9 is moot by virtue of Applicant's cancellation of that claim without prejudice.

Turning to other obviousness rejections, claims 1-6, 36 and 41 were rejected as obvious over Jean Putz et al. (Exhibit A) in view of Beal Jr. This rejection is respectfully traversed due to the fact that for the reasons set forth above, namely that claim 1 recites the step of "receiving a customer demand from the person for a custom blended lipstick at the retail establishment" which is not fairly taught by Jean Putz et al. or cured by Beal Jr. Accordingly, and based on the reasons already set forth above, it is respectfully submitted

that this obviousness rejection cannot stand because under MPEP § 2143, one of the three basic requirements for a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all the claimed limitations". Because we have already established that Jean Putz et al. (Exhibit A) is deficient, Applicant respectfully requests the obviousness rejections in paragraphs 10 and 11 to be withdrawn. However, it should also be noted for the record that neither of these references teach or disclose "applying the base pigment mixture to the lips of a person for evaluation" and thereafter "conducting heating and cooling steps". This sequence is not disclosed anywhere. If the Patent Examiner disagrees with that point, Applicant respectfully requests him to point out the specific disclosure as to this sequence. Beal Jr. does not cure the deficiencies of Jean Putz et al. as applied to claim 1, particularly since the applicator to test lip coloring at the retail establishment is already formed lipsticks (after product is formed), not custom blended lipsticks which are in process of being formed and are not completed.

Turning then to the obviousness rejections of claims 12, 13, and 14, these claims have been rejected over Jean Putz et al. in view of Beal Jr. and in further view of Lombardi et al. (and in further view of Collins as it relates paragraph 13 of the Office Action). These rejections cannot stand either due to the fact that one piece of this rejection, Lombardi et al., U.S. Patent No. 6,177,093 has the earliest filing date of March 17, 1999, whereas the present patent application claims the priority of Patent Application No. 08,924,196, with an earliest filing date of September 5, 1997. Accordingly, Lombardi et al. does not qualify as prior art and therefore these obviousness rejections fall apart altogether due to the fact that the Patent Examiner has acknowledged that Jean Putz et al. and Beal Jr. fail to establish an obviousness rejection alone. Applicant agrees that Jean Putz et al. and Beal Jr. do not specifically teach repeating the selecting, measuring, and mixing steps in order to achieve the desired shade as per page 10 of the Office Action. Therefore, removal of this rejection is respectfully solicited, as Lombardi et al. is unavailable and does not qualify as prior art. The Patent Examiner should note that claim 19 is believed to be a derived part of the original patent application filed by Applicant back in 1997, but was divided out pursuant to a restriction requirement and therefore it is believed to be fully supported by the original specification filed then.

Regarding claims 34 and 35, these obvious rejections are believed to be obviated because the underlying rejection based on Jean Putz et al. cannot stand as it relates to the base independent claims as point out above. However, it will be pointed out for the record that Applicant disagrees with the Patent Examiner's comments at page 16 of the Office Action. In particular, there is no admission of equivalence but just different types of embodiments that

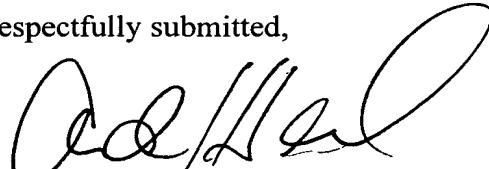
may be provided in Applicant's specification. The embodiment of the graduated sheet having graduated segments is not taught anywhere in the prior art. Obviously, different embodiments will have different utility and different advantages. By Applicant being more specific in claims 34 and 35, and the fact that the Patent Examiner cannot use Applicant's disclosure for purposes of making a rejection, since that would constitute the improper hindsight which is forbidden under obviousness law, these rejections cannot stand either. Applicant therefore respectfully requests these rejections to be withdrawn.

In view of the foregoing, Applicant is hopeful that this response will move the application along toward a Notice of Allowance and respectfully solicits the same from the Patent Examiner. Applicant would like to avert an appeal if possible, and further prosecution on this patent application for purposes of economy, and in that regard would suggest to the Patent Examiner that a telephonic interview may be fruitful to push this patent application forward.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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